



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 18

WILLIAM H. QUIRK, ESQ.
KINETIC CONCEPTS, INC.
P.O. BOX 659508
3440 E. HOUSTON STREET
SAN ANTONIO, TX 78265-9508

COPY MAIL ED

FEB 18 1999

**SPECIAL PROGRAMS OFFICE
DAS FOR PATENTS**

In re Application of
John H. Vrzalik
Application No. 08/767,291
Filed: December 16, 1996
Attorney Docket No. 7030301.1900

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed September 21, 1998, to revive the above-identified application.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

This application became abandoned for failure to timely reply to the Final Office action mailed January 31, 1997. A three month extension of time was obtained pursuant to the provisions of 37 CFR 1.136 (a). Accordingly, this application became abandoned at midnight on May 31, 1997. A Notice of Abandonment was mailed on September 9, 1997.

Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue

fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

- (2) the petition fee as set forth in 37 CFR 1.17(m);
- (3) a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and
- (4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The instant petition does not satisfy requirement (3) above.

As no petition under 37 CFR 1.137(b) was filed within either three months of notification, or one year of the date of abandonment of the above-identified application, there is a question whether the delay was unintentional. See *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997). Where there is a question whether the delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

In the instant case, petitioner, no later than September 9, 1997 (the date of mailing of the Notice of Abandonment) was aware (or should have been aware) that a petition to revive was necessary. Therefore, in addition to a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must provide a showing as to: (1) the date that petitioner (or petitioner's representative) first became aware of the abandonment of the application; (2) how any delay between the mailing of the Notice of Abandonment and petitioner's (or petitioner's representative's) discovery of the abandoned status of the application occurred; and (3) the cause of any delay between petitioner's (or petitioner's representative's) discovery of the abandoned status of the application and the filing of a petition to revive. See 37 CFR 1.137(b)(3).

Further, any renewed petition should include copies of any correspondence or communications between counsel and applicants and/or the assignee, that would rebut any inference that the filing of the first petition to revive was intentionally delayed. This showing should include, but is not limited to, docket records, tickler reports, and file jacket entries for this application.

There is no indication that petitioner herein was ever empowered to prosecute the instant application. If petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be submitted. A courtesy copy of this decision will be mailed to petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, DC 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
One Crystal Park, Suite 520
2011 Crystal Drive
Arlington, VA

Telephone inquiries concerning this matter may be directed to Petitions Attorney Patricia FL Faison at (703) 305-4497.

Frances Dickas for
Abraham Hershkovitz
Director, Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

cc:
WAYNE J. COLTON, INC.
THE MILAM BUILDING SUITE 1108
115 EAST TRAVIS STREET
SAN ANTONIO, TX 78205